

REMARKS

Claims 1-3 are pending.

In the Office Action, the claimed subject matter has been divided by the Patent Office into seven (7) groups, with claims 1-9, 12 and 13 in Group IV being deemed generic to the species disclosed therein. The groupings can roughly be delineated/summarized as follows:

1. Groups I-IV - all drawn to a method for isolating femtomolar amounts of antigenic peptides from a complex of peptide receptor with antigenic peptide wherein the peptide receptor is: MHC class I (Group I, Claims 1-51, 19-26), MHC class II (Group II, Claims 1-14, 16-27), Hsp (heat shock protein) (Group III, Claims 1-13), and other peptide receptors (Group IV, claims 1-9, 12 and 13).

2. Group V, Claim 28, drawn to a method of qualitative assessment of a vaccine,

3. Group VI, Claims 29-31 drawn to a method for monitoring disease stage, and

4. Group VII, Claims 32-33, drawn to a pharmaceutical composition comprising an antigenic peptide.

Applicants provisionally elect, with traverse, Group II, claims 1-14, and 16-27.

The Examiner has required election of one of the above groups. For the reasons set forth below, Applicants respectfully traverse the restriction.

The Examiner contends in part that all the Groups are patentably distinct from each other and thus that the searches for same would be burdensome because the

searches are alleged to be not coextensive. However, Applicant respectfully points out that this is factually incorrect for two of the groupings at issues:

Groups I and II, which are both classified in Class 530, subclass 413

Groups III and IV, which are both classified in Class 530, subclass 412

Based on the classifications and subclassifications above, Groups I and II would involve a coextensive search and Groups III-IV would involve a coextensive search. Applicants respectfully submit that the Examiner has not met her burden of establishing that the searches for all groups would be burdensome. The search required for Group I would involve the exact same search as Group II, while Groups III, and IV would likewise involve the exact same search of classification and subclassification. Indeed, the classification and subclassification system used by the PTO have recognized the similar (if not exact) status in the art.

For purposes of this response only, Applicant has provisionally elected Group II (Claims 1-14, and 16-27 directed to a method for isolating femtomolar amounts of antigenic particles from a complex of peptide receptor with antigenic peptide wherein the peptide receptor is MHC class II. Groups I also subdivides Applicants original Claims (1-15, 17-26) to those instances wherein the peptide receptor is MHC Class I (Group I). A search of Group II, classified in class 530, subclass 413 would likewise cover a search of Group I, classified in class 530, subclass 413. The searches would indeed be coextensive (if not identical). The intra-claim restriction by the Examiner is also improper; restriction within a single claim cannot be sustained under 35 USC § 121.

As noted by the MPEP 803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - 806.04(i)) or distinct (MPEP § 806.05 - 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The MPEP further notes that "For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02 ." Here however, most of the restricted groups have the same (not separate) classification and indeed have the same subclassification. The search would thus be coextensive (and not different). As MPEP 808.02 recognizes: "Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions."

Indeed, by statute, an applicant has the right to claim his invention with limitations he regards as necessary to circumscribe that invention, so long as the requirements of 35 U.S.C. § 112 are met. *In re Weber*, 198 U.S.P.Q. at 331, citing *In re Wolfram*, 179 U.S.P.Q. 620 (CCPA 1973). Further, applicant has a right to have each claim examined on the merits. The court in *In re Weber* held that the Patent Office must examine a claim on its merits and cannot refuse to examine subject matter within a single claim because such a refusal violates applicant's right to have that claim examined on the merits. In support of its holding, the court determined that if the Patent Office required a single claim to be divided and presented in several applications, the entire claim would never be considered on its merits. In particular, the court found that the totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim and that because the subgenera would be defined by the examiner rather than by the applicant, some of the fragments may not be described in the specification. The court further weighed the right of the Commissioner to divide applications for administrative and search purposes against applicant's right to have his invention

examined and held that applicant's rights are paramount. *In re Weber*, 198 U.S.P.Q. at 331-32.

Further, it is noted that 35 U.S.C. § 112, first paragraph, affords applicant the right to claim the subject matter he regards as his invention. Thus; applicants have the right to claim their invention as they contemplate it and to have that invention examined in its entirety. Nothing in 35 U.S.C. § 121, or any other statute, affords the Patent Office the right to define Applicant's invention as it contemplates.

In the instant application, Applicants have claimed what they regard as their invention in the claims filed with the instant application. Applicants submit that while the Patent Office may require election of a single disclosed species for initial examination, the Office has no authority to create a generic concept of what it determines to be Applicant's invention and especially may not by subdividing claims (intra-claim restriction). Only Applicant has the right to define his invention.

Accordingly, Applicants respectfully request that all the intra-claim restrictions be withdrawn. Applicants additionally respectfully request reconsideration and withdrawal of the restriction requirement.

The foregoing remarks are fully responsive to the Restriction Requirement issued September 7, 2006. Applicants submit claims 1-33 are allowable. Early and favorable consideration is earnestly solicited.

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No further fee is required in connection the filing of this Amendment. If any additional fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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